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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/880,016	06/14/2001	Hiroyuki Miyake	209262US2	5704

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1940 DUKE STREET  
ALEXANDRIA, VA 22314

EXAMINER

DAO, MINH D

ART UNIT	PAPER NUMBER
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2682

DATE MAILED: 03/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/880,016

Applicant(s)

MIYAKE ET AL.

Examiner

MINH D DAO

Art Unit

2682

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 6-9 is/are allowed.
- 6) ☒ Claim(s) 1-3 and 5 is/are rejected.
- 7) ☒ Claim(s) 4 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- ☒ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_.

## DETAILED ACTION

### *Response to Arguments*

1. Applicant's arguments with respect to claims 1-9 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

1. Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over the prior art of Figure 18B admitted by applicant on page 8 of the present specifications in view of Miyake (EP 1148716 A1).

Regarding claim 1, the prior art of Figure 18B admitted by applicant on page 8 of the present specifications teaches a portable telephone provided with an image pickup device, comprising: a case (Fig. 18B, items 3, 4) defining an outer shape of the portable telephone; a circuit board (Fig. 18B, item 2) provided in the case; an image pickup device, the image pickup device including a lens focusing an externally received image and an image pickup element converting the image focused by the lens to an electric signal (Fig. 18B, item1); and a lead portion electrically connecting the circuit board. However, the prior art fails to teach that the circuit board (item 2) provide in the case has an opening, and the prior art also fails to teach that the image pickup device being inserted in the opening of the circuit board. Miyake, in his invention, teaches a image pickup device which is inserted in a opening of a circuit board (Fig. 14, page 28). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to provide the teaching of Miyake to the prior art, admitted by the applicant, in order to control the focal length in the design of the image pickup device as taught by Miyake (section [0011]).

Regarding claim 2, the combination of the teachings of the prior art and Miyake teaches that the portable telephone provided with the image pickup device according to claim 1, wherein the lead portion is in a bent shape (Reference Miyake, Fig. 14, items 11) connected to the image pickup device.

Regarding claim 3, the combination of the teachings of the prior art and Miyake teaches that the portable telephone provided with the image pickup device according to claim 1, wherein the lead portion is connected to a surface of the circuit board opposite the lens (Reference Miyake, Fig. 14, items 11).

Regarding claim 4, the combination of the teachings of the prior art and Miyake teaches that the portable telephone provided with the image pickup device according to claim 1, wherein a liquid crystal display (Prior art, Fig. 18B, item 5) is provided in the case, and the lead portion includes portions of different shapes respectively formed at both sides of the image pickup device such that the image pickup device is inclined toward the liquid crystal display with respect to the circuit board (Reference Miyake, Col. 32, lines 8-11; Figs. 63B and 63C).

Regarding claim 5, the combination of the teachings of the prior art and Miyake teaches that the portable telephone provided with the image pickup device according to claim 3, wherein the circuit board has first and second surfaces respectively forming front and back sides, the case includes front and rear cases primarily covering the first and second surfaces of the circuit board respectively, and the lead portion connects the circuit board and the image pickup device such that the lens and the image pickup element are respectively positioned on the first and second surface sides of the circuit board (See Fig. 14 of Miyake, Fig. 18B of prior art).

***Allowable Subject Matter***

2. Claims 6-9 are allowed.

The following is an examiner's statement of reasons for allowance:

Regarding claim 6, the combination of the teachings of the Prior Art and Miyake teaches a portable telephone provided with an image pickup device, comprising: a case defining an outer shape of a portable telephone; a circuit board provided in said case and having a cutout portion; an image pickup device, said image pickup device including a lens focusing an externally received image and an image pickup element converting the image focused by said lens to an electric signal, and said image pickup device being mounted to said circuit board in such a way that an image can be taken in direction and perpendicular; and a lead portion electrically connecting said circuit board and said image pickup device with said image pickup device being inserted in said cutout portion of said circuit board but fails to teach that an image can be taken in direction parallel to a surface of said circuit board.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

***Conclusion***

3. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. Lee et al. (US 6,137,525) discloses Personal Communication Apparatus.
- b. Wilska et al. (US 6,427,078) discloses Device For Personal Communications, Data Collection And Data Processing, And A Circuit Card.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MINH D DAO whose telephone number is 703-305-5589. The examiner can normally be reached on 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, VIVIAN C CHIN can be reached on 703-308-6739. The fax phone number for the organization where this application or proceeding is assigned is 703-305-9508.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

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Minh Dao

Examiner

Art Unit 2682

January 15, 2004 *MD*



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SUPERVISORY PATENT EXAMINER  
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3/8/04